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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,660	08/03/2001	Klaus Heckel	22750/488	8200
26646	7590	04/05/2004	EXAMINER	
KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004			SIMONE, CATHERINE A	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/921,660	HECKEL ET AL.	
	Examiner	Art Unit	
	Catherine Simone	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,6,8,9 and 11-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6,8,9 and 11-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/14/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Withdrawn Rejections

1. The 35 U.S.C. 103 rejection of claims 1-21 over Sylvester et al. of record in the Office Action mailed 10/16/03, Pages 2-4, Paragraph #4 has been withdrawn due to the Applicant's amendment filed 1/14/04.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1, 2, 5, 6, 8, 9 and 11-21** are rejected under 35 U.S.C. 103(a) as being unpatentable over (DE 1 018 209).

Regarding **claims 1, 2, 20 and 21**, the '209 patent discloses a floor covering comprising an elastomer material having a relief-type patterned surface, wherein the surface is provided with irregularly distributed indentations (Fig. 1, #3), which have an elongated shape, which partially contact or intersect each other, and which have a depth of 0.02 mm to 0.2 mm (see translated claim 1) wherein at least one end of the indentations is configured so as to run to a point. However, the '209 patent fails to disclose the indentations having a depth of 0.025 mm to 0.05 mm, a width of 0.2 mm to 2.5 mm and 0.4 mm to 1.3 mm, a length of 5 mm to 50 mm and 6 mm

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to 40 mm and the floor covering having a thickness of 2 mm to 5 mm and 2.5 mm to 4 mm. The optimum ranges for the depth, width, length and thickness would be readily determined through routine experimentation by one having ordinary skill in the art depending on the desired end results. Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the indentations in the '209 patent with a depth of 0.025 mm to 0.05 mm, a width of 0.2 mm to 2.5 mm and 0.4 mm to 1.3 mm, a length of 5 mm to 50 mm and 6 mm to 40 mm and to provide the floor covering in the '209 patent with a thickness of 2 mm to 5 mm and 2.5 mm to 4 mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art in absence of showing unexpected results. MPEP 2144.05 (II).

Regarding **claims 5 and 6**, note each indentation intersects at least two other indentations (Fig. 1, #3). Regarding **claims 8 and 9**, note the indentations (Fig. 1, #3) have shapes that differ one from the other. Regarding **claims 11 and 12**, note the surface percentage of the indentations (Fig. 1, #3) is 5% to 50% and 20% to 40% of the total surface of the floor covering. Regarding **claim 13**, note the indentations (Fig. 1, #3) have the same depth over their entire length. Regarding **claim 14**, note the remaining surface (Figs. 1, 3 and 4, #1) of the floor covering is essentially planar. Regarding **claim 15**, note the width of the individual indentations varies (Fig. 1, #3). Regarding **claim 16**, note the length of the individual indentations varies (Fig. 1, #3). Regarding **claim 17**, note at least one of the lateral edges (Fig. 1, #2) of the indentations (Fig. 1, #3) at at least one location widens, to the outside, or narrows, to the inside. Regarding **claim 18**,

note the floor covering is assembled from individual, repeating surface units (Fig. 1, #1).

Regarding **claim 19**, note the floor covering is made up of a single layer material (Figs. 3 and 4).

Response to Arguments

4. Applicant's arguments with respect to claims 1, 2, 5, 6, 8, 9 and 11-21 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 1/14/04 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (571)272-1501.

The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Catherine Simone
Examiner
Art Unit 1772
March 30, 2004


HAROLD PYON
SUPERVISOR, PATENT EXAMINER
1772

3/31/04